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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/966,680	09/28/2001	James R. Hornsby	6881.03	5486

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EXAMINER

SUHOL, DMITRY

ART UNIT PAPER NUMBER

3712

DATE MAILED: 04/23/2003

15

Please find below and/or attached an Office communication concerning this application or proceeding.

N.K.

Office Action Summary	Application No.	Applicant(s)	
	09/966,680	HORNSBY ET AL.	
	Examiner	Art Unit	
	Dmitry Suhol	3712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 February 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5,7-10 and 12-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5,7-10 and 12-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-2, 10-11 and 20 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 12-13, 33 and 43 of copending Application No. 09/931,570 in view of Tachau et al (U.S. Patent No. 6,346,025). Copending application no. 09/931570 discloses all of the elements of the claims but for armor detachably carried by the body and protecting at least a portion of the body and the device being transformable. However Tachau discloses an amusement device, which teaches armor detachably carried by the body and protecting at least a portion of the body (fig. 8) and a device that is transformable (col. 19, lines 32-37).

This is a provisional obviousness-type double patenting rejection.

Claims 1-2 , 10 and 20 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-2 and 9 of copending Application No. 10/071545. Although the conflicting claims are not identical, they are not patentably distinct from each other because they set forth subject matters which are obvious over each other and only differ in breadth of terminology used. For example means for holding information of the application is an obvious variation in meaning of the limitation "means for keying" in the copending application 10/071545 because they are disclosed as the same feature.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1 and 12 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Regarding claim 1, the phrase "detachable during normal use of the amusement device" was not described in the specification in such a way as to reasonably convey to

one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Regarding claim 12, the structural features encompassed by the phrase “a number of data cards are configured to be used in a card game” can’t be determined. The structural features needed to play a card game is not clear. Card games take a variety of forms including games such as poker, Uno, trading baseball cards, or tossing cards into a hat, among others. Therefore it is unclear if the data cards have some sort of indicia, are they a special shape or made of a special material that allows them to be used in a “card game”?

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 20-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Li et al. Li discloses an amusement device containing all of the elements of the claims including a body (fig. 20, element A), features carried by a body (movable elements coupled to a motor described in col. 7, lines 50-64) (fig. 20, elements B), armor carried by a body is read onto the outer casing of the robot shown in figure 20 where it is considered that anything can be detached from something else by disassembly or simply breaking the pieces during any time including “normal use”, a means for

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powering a device and some features carried by the body (col. 4, lines 22-26), means for holding information (data card) (fig. 1, element 10 and col. 7, lines 59-64), means for receiving information (data card reader) (fig. 20, element 210 and col. 7, lines 59-64) where the means for receiving information is carried by a body (fig. 20, element 210), a microprocessor operably coupled to a means for powering and a means for receiving (fig. 17, element 25 and col. 5, lines 21-23). A motor associated with a body as required by claim 20 is shown as element 62 in figure 20. At least two couplings configured to couple at least two movable elements to the body (arms and legs B), as required by claim 21, are inherent in the device since without the couplings the device would not be able to function.

Claims 5, 7-9, 15-16 are rejected under 35 U.S.C. 102(b) as anticipated by Simms or Pearson et al or, in the alternative, under 35 U.S.C. 103(a) as obvious over Simms in view of Gabai et al. Pearson discloses a game method using a number of information carrying cards containing all the elements of the claims including, compiling a number of information carrying cards and distributing collectable cards to players as required by claims 5 and 15 (col. 3, lines 35-50 and figure 2), players (at least two as required by claim 15) using the game information against each other to try to achieve victory over other players as required by claim 9 (col. 3, lines 35-50 and figure 2). The cards of Pearson are shown to have game information (indicia 24) and device actuation information (control data 21) as required by claims 5 and 15-16.

Simms discloses a game method using a number of information carrying cards containing all the elements of the claims including, compiling a number of information carrying cards and distributing collectable cards to players (col. 5, lines 43-48), players (at least two as required by claim 15) using the game information against each other to try to achieve victory over other players (col. 6, lines 11-21). Simms further discloses, using information carried by cards to actuate amusement devices as required by claim 6 (abstract) where it is considered that since images are displayed on a video screen of a computer (considered to be an amusement device) there are parts that are actuated in response to reading the images. Furthermore it is considered that the computer (amusement device) acts according to and in association with control information carried on a card and games being played, as required by claims 7 and 8, since it displays images carried by the cards relating to a wrestling game. The cards of Simms are shown to have game information (image 13) and device actuation information (control data as described in col. 4, lines 30-31) as required by claims 5 and 15-16.

If Simms is later deemed not to meet claims 5, 7-9 because Simms does not disclose using information carried by cards to actuate amusement devices and amusement device acting according to and in association with control information carried on a card and games being played, then it would have been obvious to combine the teachings of Gabai of providing a doll or figure which is movably responsive to a game played on a computer (col. 9, lines 9-44) for the purpose of interest to a user and added realism.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-4 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lebensfeld et al in view of Mathieu et al. Lebensfeld discloses an interactive amusement device capable of a variety of scenarios and using a multiple of different accessories (col. 4, lines 56-62), containing most of the elements of the claims including, a body as required by claims 2 and 10 (fig. 4, element 10), at least two transport elements movably connected to a body as required by claim 2 (fig. 1, legs), at least two arms movably connected to a body as required by claim 2 (fig. 1, elements 47 and col. 7, lines 31-36), a microprocessor as required by claims 2 and 9 (figure 6, element 60), a data card reader associated with a body and adapted to receive and transmit enhancement data to a microprocessor in order to enhance a function of a device is obvious since the device is made to receive upgrade data as required by claims 2 and 10 (col. 9, lines 35-43) where a computer is considered to be a card reader since a computer clearly reads information from floppy disks/cards through a disk drive and a device being able to transform into at least two different forms as required by claim 2 (col. 10, lines 49-53) where it is considered that an addition of any accessory would be a different form of the device. Data providing changes for at least two functions, as required by claim 10, is taught in col. 9, lines 35-43 where it is clearly

stated a computer may be used to upload/download programming, features, functions and use information. Changes being speed of functions, as required by claim 10, is described in col. 6, lines 26-28 where single shot, semi-automatic shooting and automatic shooting is clearly a speed of a shot function.

Although Lebensfeld et al discloses most of the elements of the claims the reference fails to teach a motor associated with a body and coupled to two transport elements as required by claims 2 and 10, a wireless receiver associated with a body as required by claims 2 and 10, a unit wireless transmitter associated with a body and coupled with a microprocessor as required by claims 2, 4 and 10, a remote wireless transmitter operably coupled with a wireless receiver as required by claims 2 and 10, a remote wireless transmitter operably coupled with a wireless receiver as required by claims 2 and 10, a launchable element connected to a body with a motor connecting the element and a launch mechanism as required by claim 3. However, Mathieu discloses an interactive amusement device like that of Lebensfeld, which teaches a motor associated with a body and coupled to two transport elements (fig. 6, elements 42), a wireless receiver associated with a body (fig. 8, element 64), a unit wireless transmitter associated with a body and coupled with a microprocessor (figure 1, element 20), a remote wireless transmitter operably coupled with a wireless receiver (figure 1, element 46). Therefore it would have been obvious in view of Mathieu, to manufacture the device of Lebensfeld with the above mentioned features for the purpose of providing a remote controlled device that can simulate a "battle" scenario. Furthermore it would have been obvious to provide a launchable element with a launching mechanism and a

motor connected to the mechanism since Lebensfeld discloses multiple scenarios and accessories.

Claims 3-4, 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tachau et al. Tachau discloses an interactive amusement device containing most of the elements of the claims in a variety of embodiments including, a body as required by claims 3 and 17 (figure 1A), a launchable element connected to a body as required by claims 3 and 17 (figure 1A, element 110A), a launch mechanism (col. 4, lines 28-33) coupled to a launch element (110A) as required by claims 3 and 17, a motor operably coupled to a launch mechanism as required by claim 3 (col. 4, lines 28-33), a means for communicating with a user as required by claim 4 (col. 9, lines 62-66). Tachau further discloses that his invention can take a variety of forms (figures 6, 7, 10, 11a among others) in which some of the forms (i.e. figure 10) propel a launchable element away from a body as required by claim 17, described in col. 21, lines 32+. A data card reader and a data card, as required by claim 18, are read onto a cartridge and the associated circuitry used to read the information contained therein, described in col. 10, lines 14-21. Furthermore, data adding a function to a device, as required by claim 18, is described in col. 9, lines 55-56 and further in col. 14, lines 49-61 where a "damage" scenario is described which adds functions such as release of a portion of the airplane. At the same time the "damage" scenario also enhances an existing function of the device, as required by claim 19, by providing more sounds (related to the specific scenario) described in col. 14, lines 54-55. Therefore it would have been obvious to

combine the teachings of Tachau in order to produce an interesting and upgradable amusement device that is capable of a plurality of play scenarios to amuse the user.

Claims 10 and 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lebensfeld et al and Mathieu et al, as stated above, in view of Li et al. Lebensfeld, as modified by Mathieu, discloses most of the elements of the claims including figures that may take form of robots that have uploadable functions such as speech, movement among others as well as a control switch 20 (as required by claims 13 and 14). Li teaches that a toy figure/robot that has uploadable functions including speech and movement through a data card and data card reader (col. 7, lines 59-64). Furthermore it is considered that a data card (10) of Lee is configured to be used in a card game, as required by claim 12, since the card clearly shows interesting indicia that can be collected, traded, arranged around a playing area and played with or the card can just be tossed into a hat (as is known with the use of playing cards). Therefore it would have been obvious incorporate the teachings of Li, in place of the computer of Lebensfeld in order to manufacture a toy with easily upgradeable functions such as sound and movement.

Response to Arguments

Applicant's arguments filed 11 February 2003 have been fully considered but they are not persuasive. Applicants' argue that "Li does not disclose armor adapted to be detachable during normal use of the amusement device". The examiner disagrees

and points out (as stated in the office action) that anything is detachable by disassembly or simply breaking the pieces apart at any time (including during normal use). Examiner further points out that applicants use the term "adapted to" where it has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

Applicants' further argue that Simms does not disclose control information while Pearson does not disclose game information. Examiner disagrees, as stated in the office action, both Simms and Pearson disclose both game and control information, where game information show by the images on the data cards while control information is clearly shown in the control means disclosed by both references, and both of the references teach multiple players playing against each other while an amusement device is actuated.

Additionally, applicants' argue that Lebensfeld fails to teach a card reader adapted to receive enhancement data from a data storage device and transmit the data to a microprocessor. The examiner disagrees and points out that Lebensfeld clearly teaches upgradable amusement devices associated with a computer (data card reader) capable of receiving information from a data card (floppy disk).

Applicants' further argue that Lebensfeld teaches away from the combination with Mathieu. Examiner agrees that Lebensfeld speculates of the deficiencies of U.S. Patent 4,938,483 however the Mathieu reference is not Patent 4,938,483 and the generalities of the speculative deficiencies of patent 4,938,483 do not have to apply to

the Mathieu reference. Furthermore, even though Lebensfeld discusses the deficiencies of 4,938,483, the device of Lebensfeld is similar in nature and use the same/similar components. For example, Lebensfeld clearly states that his inventions encompasses the use of a remote control device to control a variety of functions of the toy (col. 3, lines 18-25). Therefore not only is the combination of Lebensfeld and Mathieu appropriate by actually taught/implied by the Lebensfeld reference.

Regarding the lack of launching capabilities of Lebensfeld, the reference clearly states that his invention can take a variety of forms (col. 10, lines 56-59) where it is well known that toys embodied by such a variety of forms very often incorporate a launchable (simulated) weapon (i.e. Tachau et al), therefore it would have been obvious to incorporate a launch mechanism and a launchable element as required by claim 3 for the purpose of added realism and interest to the consumer.

Regarding applicants' arguments with respect to Tachau, examiner points out that the reference clearly teaches a launchable element and launch mechanism (as stated above in the office action), and goes further to describe a variety of embodiments some of which teach a spring-loaded projectile (col. 21, lines 32+).

Therefore the claims stand rejected as stated above, and in the previous office action.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dmitry Suhol whose telephone number is 703-305-0085. The examiner can normally be reached on Mon - Friday 9am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on 703-308-1745. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

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A handwritten signature in black ink, appearing to read 'DHB', with a long horizontal line extending to the right.

DERRIS H. BANKS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700